

REMARKS**Overview**

Claims 1-16 and 18-89 are pending in this application. The present response is an earnest effort to traverse all rejections and secure the Examiner's agreement that all claims are in proper form for allowance. It is respectfully submitted the present response either places claims in form for allowance or in better form for appeal. Therefore, entry of this response and reconsideration of this application is respectfully requested.

Claims 1-16, 18, 19, 21, 31-50 and 52-54 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,340,790 to Gordin et al in view of U.S. Patent No. 4,543,764 to Kozikowski.

Claims 20, 22-27, 51, 55-64, 67-81 and 84-89 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over Gordin in view of Kozikowski further in view of U.S. Patent No. 3,968,561 to Oakes.

Claims 28-30, 82 and 83 have been rejected as being unpatentable over Gordin in view of Kozikowski further in view of U.S. Patent No. 4,092,079 to Swanson.

Claims 65 and 66 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over Gordin in view of Kozikowski in view of Oakes and in further view of Swanson.

These rejections are respectfully traversed.

Status of the Claims

Independent claims 1, 42, 54, 56 and 73 have been amended to describe one aspect of the invention. Certain other minor changes have been made to the claims for purposes of correcting dependency or grammatical matters.

Issues Under 35 U.S.C. § 103

To establish a *prima facie* case of obviousness, three basic criteria must be met. "First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations." MPEP § 2143. "The teaching or suggestion to make the claim combination and the reasonable expectation of success must both be found in the prior art, not in the applicant's disclosure." *Id.*

Claims 1-16, 18, 19, 21, 31-50 and 52-54 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,340,790 to Gordin et al ("Gordin") in view of U.S. Patent No. 4,543,764 to Kozikowski ("Kozikowski").

Independent claim 1 has been amended to describe one aspect of the present invention. In particular, amended claim 1 defines an apparatus for use with "substantially tall tapered poles". Support for this can be found at least at Specification, page 14, line 13, and Figures 1-3. Amended claim 1 also specifies the layer is "a fraction of an inch thick". Support can be found at least at page 5, line 9, and page 9, line 15 of the Specification. Also, claim 1 specifically states the layer is formable "into a truncated cone of at least several inches diameter substantially matching a certain taper". Support can be found at least at page 7, lines 10-17, page 10, lines 13 and 14 of the Specification. Finally, amended claim 1 adds language clarifying that the layer is held in place against downward movement by the substantial match of its taper when formed in the truncated cone relative to the certain taper. The certain taper would be that for a section of

the pole to which the covering layer is designed to fit. The combination of elements of claim 1 is not disclosed by the combination of Gordin and Kozikowski.

Gordin does not disclose a sleeve positionable around an existing pole, contrary to the Examiner's contention. Instead, Gordin discloses a hollow pole that can be stacked upon a base member in the erection of a light pole (see Abstract). The pole, being positioned on the base member, provides the structural support that allows for the suspension of elevated structures. In the current application, the claimed external layer covering the pole provides essentially no structural support in the sustaining of elevated structures. This is especially true when comparing the amount of structural support provided by the pole versus the structural support provided by the covering layer. A plastic, fraction of inch thick layer, does not form any material part of supporting the underlying pole or whatever the pole might elevate.

Importantly, Gordin teaches nothing about a plastic covering layer. This is in direct contrast to what Gordin discloses. Gordin teaches nothing about a covering sleeve or layer.

Kozikowski does not teach, disclose, or suggest Applicant's claim 1. Kozikowski does not teach a plastic, fraction of an inch thick, covering layer formable in a truncated cone to be held in position for downward movement on the pole by simply matching its taper with a certain taper for a pole to which it is to be applied. The drawings of Kozikowski show a straight pole. Rods 18, stubs 20 and staples 22 intentionally space the jacket 24 from the pole to create a void between the jacket and the pole (Kozikowski col. 4, lines 46-49). Kozikowski teaches cinching the jacket 24 around rods, studs and/or staples on the pole (col. 4, line 59) and/or screwing it to the pole (col. 4, line 66). After jacket 24 is in position, an inert filler material is poured "between jacket 24 and pole 12" (col. 5, lines 9-10). The filler "will typically be comprised of an epoxy

resin" (col. 5, lines 13-14), to fill the void. The filler also bonds to the jacket and to the pole (col. 5, lines 16-17).

Thus, in direct contrast to the present claim 1, Kozikowski specifically teaches away from the present claimed invention. What it calls its "jacket 24" is really a form that is secured by separate cinching means or screws around spacing hardware to intentionally create a void or space between it and the pole. This allows the epoxy to be poured in and form a structural repair of the pole at that location. The filler epoxy adheres both to the pole and jacket 24. Applicant's claim 1, instead describes a thin plastic cover formed into a truncated cone that can be wrapped or slid over a tapered section of a pole and held in place against downward movement only by closely matching the taper of the truncated cone with the taper of the pole. In other words, the covering layer is in abutment with the exterior of the pole -- it does not define a void like Kozikowski into which a hardening, structural material like epoxy can be paired.

Additionally, Kozikowski also does not disclose a plastic covering layer that provides no structural support of the structure being elevated. Instead, Kozikowski discloses a structure with a sole purpose to strengthen and add structural integrity to a pole and, thus, to what is elevated by the pole. The epoxy also hardens and bonds to both jacket 24 and the pole. "The inert filler material will typically be comprised of an epoxy resin. It is to be understood that this inert filler material must be compatible with and given excellent bond to the jacket and to the standing pole with which it is used." (*emphasis added*) (col. 5, lines 13-17). The sleeve bonds and becomes integrated with bracing rods to provide a structural support to a compromised pole. Kozikowski does not disclose a plastic cover that provides no structural support in sustaining elevated structures.

Further, there is no motivation to combine Gordin with Kozikowski. Gordin's hollowed pole provides support to an elevated structural device. The overlapping portion of the pole disclosed in Gordin must be of sufficient strength to prevent the pole from shearing off because of the lateral forces. It cannot be said that a plastic cover a fraction of an inch thick would be a sufficient strength to allow Gordin's elevated pole to operate satisfactory for its intended purpose. "If the proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification." See MPEP § 2143.01 citing In re Gordon, 733 F.2d 900 (Fed. Cir. 1984).

The combination of Gordin and Kozikowski does not disclose each limitation of independent claim 1. Additionally, the combination does not provide any motivation to combine the two references as the combination suggested by the Examiner would render Gordin unsatisfactory for its intended purpose. Therefore, it is respectfully submitted that the Examiner should withdraw this rejection of claim 1. As claims 2-16 and 18, 19, 21, and 31-41 depend from allowable claim 1, Applicant respectfully requests that the Examiner also withdraw these rejections.

The method of independent claim 42 has also been amended to include similar limitations as in claim 1. The combination of Gordin and Kozikowski does not disclose these limitations nor disclose any motivation to combine the two references as was discussed in relationship to claim 1. Applicant respectfully requests that the Examiner withdraw the rejections to claim 42 for similar reasons. As claims 43-50, 52 and 53 depend from claim 42, Applicant requests that these rejections also be withdrawn.

Independent claim 54 has been amended to include similar limitations as in claim 1. Claim 54 includes a pole as a part of the claim. As discussed previously, neither Gordin nor

Kozikowski disclose these limitations. Neither does either prior art reference, expressly or inherently, disclose any motivation to combine the two references. Hence, no *prima facie* case of obviousness is made out. Therefore, Applicant respectfully requests that the Examiner withdraw the rejections to independent claim 54.

Claims 20, 22-27, 51, 55-64, 67-81 and 84-89 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over Gordin in view of Kozikowski further in view of U.S. Patent No. 3,968,561 to Oakes ("Oakes").

Claims 20, and 22-27 are dependent from amended claim 1 and submitted to be allowable for the reasons expressed in support of claim 1. Oakes does not remedy any gap in teaching of claim 1 by Gordin and Kozikowski. Claims 51 and 55 are dependent from amended claims 42 and 54, respectively, and submitted to be allowable for the reasons they are allowable.

Independent claim 56 has been amended to include similar limitations to those of claim 1. As discussed with reference to independent claim 1, neither Gordin nor Kozikowski disclose these limitations. The inclusion of Oakes does not solve this deficiency.

Oakes discloses a hollow structural form of thin sheet metal that encapsulates lightweight synthetic plastic foams. Oakes is non-analogous art as it is not within the field of the inventor's endeavor, nor reasonably pertinent to the particular problem of protecting substantially tall poles. In addition to this, Oakes does not disclose or teach an external covering over a pole structural support. Oakes also does not disclose or teach forming a truncated cone which matches a certain taper to hold the cone against downward movement relative to a pole because of the substantially matching taper.

As the cited art fails to disclose each of the limitations of independent claim 56, Applicant respectfully requests that the Examiner withdraw this rejection. As claims 57, 64, and 67-72 depend from claim 56, Applicant submits that they are in proper form for allowance.

Independent claim 73 has been amended to include similar limitations as claim 1. For the reasons discussed in reference to independent claim 56, Applicant believes that claim 73 as amended is in proper form for allowance. As claims 74-81 and 84-89 depend from claim 73, Applicant respectfully requests that the rejections to these claims also be withdrawn for the aforementioned reasons.

Claims 28-30, 82, and 83 have been rejected under 35 U.S.C. § 103(a) as unpatentable over Gordin in view of Kozikowski and further in view of Swanson U.S. Patent 4,092,079 ("Swanson"). Swanson teaches a way of replacing an existing utility pole without disturbing hardware mounts to the pole. Swanson discloses a sleeve 38 that bridges the new and old section of the pole and thus provides the support necessary to support the elevated structures. This is in direct opposition to the current application that requires that the sleeve about the pole provide no structural support relative to the structural support provided by the pole. As Swanson does not disclose these limitations as required by each and every independent claim, Applicant respectfully requests that any rejections incorporating Swanson also be withdrawn for failing to teach each and every limitation of the pending claims and now is in proper form for allowance. Further, Applicant submits that there is no motivation to combine any of the prior art references.

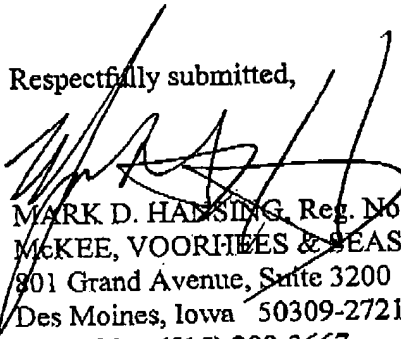
Claims 28-30 and 82, 83 are dependent from claims 1 and 73 respectively, and submitted to be allowable for similar reasons. Swanson does not provide missing disclosure or teaching in these references.

Claims 65 and 66 have been rejected as obvious under 35 U.S.C. § 103(a) on the basis of a combination of Gordin, Kozikowski, Oakes, and Swanson. Claims 65 and 66 are dependent from claim 56 and submitted to be allowable for similar reasons.

Conclusion

No fees or extensions of time are believed to be due in connection with this amendment; however, consider this a request for any extension inadvertently omitted, and charge any additional fees to Deposit Account No. 26-0084.

Respectfully submitted,



MARK D. HALSING, Reg. No. 30,643
MCKEE, VOORHEES & SEASE, P.L.C.
801 Grand Avenue, Suite 3200
Des Moines, Iowa 50309-2721
Phone No: (515) 288-3667
Fax No: (515) 288-1338
CUSTOMER NO: 22885

Attorneys of Record

- MDH/JL/bja/pw -